

REMARKS

Applicant has carefully reviewed the Office Action of August 25, 2005 and offers the following remarks to accompany the above amendments.

Applicant amends claim 1 to include the subject matter of claims 8 and 12. Claims 13, 17, 22, and 23 are amended to include the subject matter of claim 21. No new matter is added.

Applicant cancels claims 8, 12, and 21. Applicant adds three new dependent claims. As the total claim count remains unchanged, no new fee should be required.

Applicant adds new claim 24 which recites that the memory and the body are integrally formed with one another such that the memory is not readily removed from the body. Support for this amendment can be found in Figures 2A-2C, which shows a USB key, a transponder, and a smart card. As is well understood, these devices are unitary devices that do not readily allow memory to be removed from their respective bodies. No new matter is added.

Applicant adds new claim 25 which recites that the memory contains at least four megabytes of flash memory. Support for this amendment can be found in paragraph 0024. No new matter is added.

Applicant adds new claim 26 which recites that the cleansing indicia includes instructions to de-register the cryptographic service provider so as to prevent access to selected functions, services, and drivers after the portable device has been removed. Support for this amendment can be found in paragraph 0044. No new matter is added.

Claims 1-23 were rejected under 35 U.S.C. § 103 as being unpatentable over Klemba et al. (hereinafter “Klemba”) in view of Bialick et al. (hereinafter “Bialick”). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once a proper combination has been made, to establish *prima facie* obviousness, the Patent Office must still show where each and every element of the claim is taught or suggested within the combination of references. MPEP § 2143.03.

Applicant initially traverses the rejection because the Patent Office has not properly supported the combination of references. Specifically, the Patent Office asserts that the motivation to combine the references is “because the storage device provides a place for the

cryptography module to place files during processing.” (Office Action of August 25, 2005, page 4, lines 5-6). This asserted motivation lacks the required evidence. Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the claims are allowable. Applicant requests withdrawal of the § 103 rejection on this basis.

The Patent Office provides an alternate basis for combining the references for claims 17 and 22. For these claims, the Patent Office asserts that the motivation to combine the references is “because the storage device works from the point of connection onward.” (Office Action of August 25, 2005, page 8, lines 4-5). This asserted motivation also lacks the required evidence. Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the claims are allowable. Applicant requests withdrawal of the § 103 rejection on this basis.

Applicant further notes that the motivations do not compel the combination. If the motivation is to have a storage location, then the host computing device of either reference has a memory element associated therewith and storage may be effectuated therein. Thus, there is no need to combine the references to achieve the desired storage function. Since the motivation does not compel the combination, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the claims are allowable. Applicant requests withdrawal of the § 103 rejection on this basis.

Even if the combination is proper, a point that Applicant does not concede, the combination still does not establish obviousness. As all the claims now include the subject matter of claims 12 and 21, Applicant specifically addresses the rejection of claims 12 and 21. The Patent Office asserts that the cleansing indicia for removal of at least certain information from the host computing device is shown at Klemba col. 7, lines 7-10. Applicant respectfully traverses this assertion. Klemba, col. 7, lines 7-10 states in full “...user/unit. This aspect of the invention allows the system to be very dynamic, yet preserves physical control of the system, such that the enabled application (in this example cryptography) is lost if the policy is removed from the NSS.” While the passage indicates that the enabled application is lost, there is no

teaching or suggestion that this loss is performed by cleansing indicia as recited in claim 1 or by removal instructions as recited in claims 13 and 23. Likewise, it is not entirely clear that "losing" the application is the same as the removing of claims 17 and 22. Thus, Klemba does not teach or suggest the element for which it is cited. Nothing in Bialick cures the deficiencies of Klemba. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination of references does not teach or suggest the claim element, the combination does not establish obviousness. Since the combination does not establish obviousness, the claims are allowable. Applicant requests withdrawal of the § 103 rejection on this basis, as well.

New claims 24-26 deserve special mention. New claim 24 recites that the body and memory are integrally formed with one another such that the memory is not readily removed from the body. In contrast, Klemba clearly contemplates that the policy is removed from the cryptographic unit 20. The Patent Office is not free to ignore this portion of Klemba. Since Klemba teaches away from the claimed invention, the claim is non-obvious.

New claim 25 recites that the memory contains at least four megabytes of flash memory. Applicant has studied the references and finds no teaching or suggestion of the size of the memory therein. Since the references are silent on the size of the memory, the claim element is not taught or suggested. Since the claim element is not taught or suggested, the claim is non-obvious.

New claim 26 recites that the cleansing indicia includes instructions to de-register the cryptographic service provider. De-regulation is done to prevent access to selected functions, services, and drivers after the portable device has been removed. Even if Klemba's losing is somehow the same as the cleaning indicia of claim 1, a general allegation of losing does not equate to the de-registering and prevention of access to selected function, services, and drivers as recited in the claim. Thus, the combination does not teach or suggest this element. Since the element is not taught or suggested, the claim is non-obvious.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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